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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,723	08/20/2003	Travis T. Hailey JR.	2003-IP-009460 UI USA	6112

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03/02/2006

EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/644,723

Applicant(s)

HAILEY, TRAVIS T.

Examiner

Jennifer H. Gay

Art Unit

3672

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-52 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7, 10, 15-23, 25, 26, 29-31, and 34-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Malone (US 3,085,628).

*Regarding claim 1:* Malone discloses an inflatable well completion tool that includes an inflatable element 13 and a particulate filter 30' coupled to the element. The element is inflated by fluid filter by the filter. *The examiner notes that Malone does not specifically disclose using the tool with gravel slurry, however, the tool would be capable of filtering fluid from gravel slurry if this was the fluid used to inflate the element.*

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

*Regarding claims 2, 19, 39:* The element is capable of movement between a deflated and an inflated state where the element moves expands in a radial direction.

*Regarding claims 3, 45:* The element includes a top end 11, a bottom end 12, an interior (Figures 2A and 2B), and a passageway 21, 22 allowing communication of the fluid between the top of the element and the interior of the element.

*Regarding claims 7, 15, 18, 30, 37, 38, 46:* The passageway includes a check valve 23.

*Regarding claim 10:* Malone discloses an isolation packer that includes the following features:

- An inflatable element 13.
- A passageway 21, 22 between the exterior and interior of the element.
- A particulate filter 30' in the passageway. The element is inflated by fluid filter by the filter. *The examiner notes that Malone does not*

*specifically disclose using the tool with gravel slurry, however, the tool would be capable of filtering fluid from gravel slurry if this was the fluid used to inflate the element.*

It has been held that the recitation that an element is “capable of” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

*Regarding claim 16:* The packer includes a tubular body 5 attached to the element.

*Regarding claims 17, 29, 34:* Malone discloses a wellbore isolation device that includes the following features:

- A tubular body member having a first 17 and second 19 segment where each segment includes an exterior and an longitudinal bore.
- A bladder 13 surrounding the second segment and having a wall, interior, upper end, and lower end (Figures 2A and 2B).
- A passageway 21, 22 located adjacent the first segment and extending through the wall of the element.
- A filter 30' located in the passageway and coupled to the interior of the bladder. The element is inflated by fluid filter by the filter. *The examiner notes that Malone does not specifically disclose using the tool with gravel slurry, however, the tool would be capable of filtering fluid from gravel slurry if this was the fluid used to inflate the element.*

It has been held that the functional “wherein” statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957). The structure defined by the applied reference need merely be capable of or able to perform the functional language included in the “wherein” statement.

*Regarding claims 20, 31:* The bladder is indirectly attached to the tubular body member.

*Regarding claim 22:* The second segment includes an upper packer head 11 and a lower packer head 12 where the upper end of the bladder is connected to the upper packer head and the lower end of the bladder is connected to the lower packer head.

*Regarding claims 23, 25:* The passageway extends through the upper packer head and communicates between the exterior, i.e. the surface from where the fluid is pumped into the system, of the first segment and the interior of the bladder.

*Regarding claims 26, 34, 35, 36:* The tubular body member includes a third segment (Figure 2A) and the passageway enables communication between the exterior of the first and third segments and the interior of the bladder.

*Regarding claim 40:* The bladder forms a seal between the tubular body and the wellbore wall.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4-6, 8, 9, 11-14, 24, 27, 28, 32, 33, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malone in view of Watson et al. (US 6,575,251).

*Regarding claims 4, 5, 11, 12, 27, 28, 32, 33, 41, and 42 :* Malone discloses all of the limitations of the above claims except for the passageway being a shunt tube or alternative channel.

Watson et al. discloses a tool similar to that of Malone. Watson et al. further teaches the use of a shunt tube to deliver the inflation fluid to the inflatable element.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the tool of Malone such that the passageway was a shunt tube as taught by Watson et al. in order to have allowed fluid communication but further restricted particulate communication (3:19-38).

*Regarding claims 6 and 24:* Malone discloses all of the limitations of the above claims except for the passageway extending through the upper and lower packer heads to

allow communication between the exterior of the first and second segments or the lower packer head and the interior of the bladder.

Watson et al. further discloses that the passageway could extend through the upper and lower packer heads to allow communication between the exterior of the first and second segments or the lower packer head and the interior of the bladder (3:19-38).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified Malone such that the passageway extended through the upper and lower packer heads to allow communication between the exterior of the first and second segments or the lower packer head and the interior of the bladder as taught by Watson et al. in order to have allowed wellbore fluid outside the inflatable element to be used to inflate the bladder.

*Regarding claims 8, 9, 13, and 14:* Malone discloses all of the limitations of the above claims except for the tool including a first and second screen with the inflatable element being located there between.

Watson et al. further discloses using the tool in a sand completion that includes multiple screens with the inflatable element being located therebetween (8:55-9:2).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the tool of Malone to include the sand screens taught by Watson et al. in order to have been able to work on several formations at once while still isolating the zones from one another.

5. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Malone in view of Szarka (US 4,627,488).

Malone discloses all of the limitations of the above claims except for the system including a cup packer.

Szarka discloses a isolation packer system similar to that of Malone. Szarka further teaches the use of cup packers **774**, **776** with the system.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the system of Malone to include a cup

packer as taught by Szarka in order to have preventing downward flow of fluid thus creating a pressure seal around the packer (13:49-51).

6. Claims 1-42 and 44-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al. in view of Malone or Wilson et al. (US 2004/0020644).

*Regarding claims 1, 10, 17, 29, and 39:* Watson et al. discloses a wellbore isolation device that includes the following features:

- A tubular body member having a first 17 and second 19 segment where each segment includes an exterior and an longitudinal bore.
- A bladder 13 surrounding the second segment and having a wall, interior, upper end, and lower end (Figures 2A and 2B).
- A passageway 21, 22 located adjacent the first segment and extending through the wall of the element.

*Regarding claims 44 and 49:* Watson et al. discloses a method of using the above device that involves the following steps:

- Providing a sand screen completion including the inflatable element.
- Gravel packing at least a portion of the well with a gravel slurry.
- Using the gravel slurry to inflate the element.

Watson et al. discloses all of the limitations of the above claims except for a particulate filter located in the passageway for filtering fluid from the gravel slurry.

Malone and Wilson et al. disclose isolation packer systems. Malone and Wilson et al. further teach that it is known to filter the inflation fluid.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the system of Watson et al. to include a filter means as taught by Malone and Wilson et al. in order to have prevented damage to the inflatable element and to have prevented a build up of debris in the inflatable element thus hampering the deflation of the element.

*Regarding claims 2-9, 11-16, 18-28, 30-38, 40-42, 45-48, and 50-52:* Watson et al. discloses all of the features of the above claims (see 3:1-38, 7:30-35, 7:49-51, and 8:55-9:2)

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watson et al. in view of Malone or Wilson et al. as applied to claim 39 above, and further in view of Szarka.

Watson et al., Malone and Wilson et al. disclose all of the limitations of the above claims except for the system including a cup packer.

Szarka discloses a isolation packer system similar to that of Malone. Szarka further teaches the use of cup packers 774, 776 with the system.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the system of Watson et al. in view of Malone or Wilson et al. to include a cup packer as taught by Szarka in order to have preventing downward flow of fluid thus creating a pressure seal around the packer (13:49-51).

### ***Response to Arguments***

8. In view of applicant's amendment, the objections to the drawings have been withdrawn.
9. Applicant's arguments filed September 29 2005 have been fully considered but they are not persuasive.

Applicant has argued that Malone does not teach that the filter 30' is used to separate gravel from a slurry or using the filter slurry to fill the inflatable member 13. Applicant further argues that the examiner's assertion that Malone would be capable of performing this function is not a proper basis for a rejection.

As stated above and in the previous Office Action, the examiner agrees that Malone does not teach filtering fluid from a gravel slurry and using that fluid to inflate an inflatable member. However, as also noted above and in the previous Office Action, the packer of Malone would be capable of or able to perform this function.

When the terms "wherein", "adapted to", or "capable of" are used in a claim the functional language that proceeds these terms is considered merely that, functional language, and is given little patentable weight. The structure of the applied reference need merely be able to perform the functional recited in the claim and a specific



recitation that such a function is performed is not necessary for the reference to read over the claim.

As related to the Malone reference, though the reference does not each filtering a gravel slurry and using the filtered fluid to fill an inflatable member, it is taught to filter the inflation fluid used where the inflation fluid is pumped down the central tubing of the apparatus. Therefore, if a gravel slurry was injected into the wellbore, the tool of Malone would be capable of or able to filter the slurry from the gravel using the filter 30' which is located between the central tubing of the tool and the inflation passage of the packer. The mere fact that Malone does not teach the use of a gravel slurry is irrelevant, as any fluid pumped into the wellbore would be filtered by the packer before the fluid being used to inflate the packer.

This same argument was used against the use of Wilson.

Applicant has also argued that neither Watson nor Szarka teaches filling an inflatable element with an inflation fluid obtained by filtering the particulates from a gravel-laden slurry. While the examiner agrees, it is noted that neither Watson nor Szarka were used for such a teaching. Applicant is arguing Watson and Szarka as if applied under 35 USC 102 instead of 35 USC 103.

In response to applicant's argument, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

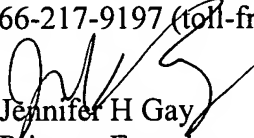
Art Unit: 3672


MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H Gay  
Primary Examiner  
Art Unit 3672

JHG   
February 21, 2006